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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,532	02/25/2004	William Malecki	022128-000130US	1226

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,532

Applicant(s)

MALECKI ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-156 is/are pending in the application.
- 4a) Of the above claim(s) 5-13, 27, 34-38, 40-45, 47-136 and 149-155 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 14-26, 28-33, 39, 46, 137-148, 156 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/20/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

7/18/05
4/29/05
1/24/05
1/14/05

Claim Numbering

Applicant has added new claims 137-155. However, there are two claims numbered 146. As such, the second claim 146 has been renumbered as claim 147 with the remainder of the claims (including dependencies) renumbered through claim 156 accordingly. Applicant's future responses should reflect this renumbering.

Election/Restrictions

Applicant has conditionally elected an embodiment shown in figures newly added. In particular, applicant has indicated the election of Figure 21. There is no "Figure 21", but rather Figure 21A and Figure 21B, each representing a distinct species. In the interest of further prosecution, applicant is deemed to be electing Figure 21A for prosecution. Applicant has further indicated that claims 1-26, 28-33, 39-46 and newly added claims 137-156 all read on the elected embodiment of Figure 21A. It is the examiner's position that claims 5-13, 40-45 and 149-155 do not read on the elected embodiment. With regard to claims 5-13 and 149-155, there is nothing in the disclosure that suggests the newly added embodiment is capable of being used at various locations. Concerning claims 40-45, there is no disclosure of a monitoring means located on the device embodied in Figure 21A. As such, applicant's election without traverse of the invention of Group I to the method of treating tissue is acknowledged. Further, applicant's election of the species of Figure 21A is acknowledged, and claims 1-4, 14-26, 28-33, 39, 46, 137-148 and 156 are deemed to read on the elected embodiment. Claims 5-13, 27, 34-38, 40-45, 47-136 and 149-155 are withdrawn as being directed to a non-elected invention and/or species.

Specification

The amendment filed July 31, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figures 22A-22D, 23 and 24 and their associated description in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

The examiner has found support in US Provisional Serial Number 60/478,035 for the subject matter of newly added Figures 21A and 21B (and the corresponding description). However, the examiner has not found the subject matter of Figures 22A-22D, 23 and 24 in that provisional application, or any of the other provisional applications from which priority is claimed. Applicant has not indicated the source of the support for the subject matter added for Figures 22A-22D, 23 and 24.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 14-26, 28-33, 39, 46, 137-148 and 156 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,939,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps recited in the patented claims and the instant application claims recite only minor, obvious differences.

Claims 1-4, 14-26, 28-33, 39, 46, 137-148 and 156 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending Application Nos. 10/665,974; 10/811,228; 10/873,348; 11/053,274; and 11/249,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are only minor, obvious differences between the instant application claims and the method claims of the other pending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stambaugh et al (WO 99/18871) is the closest prior art and teaches providing a balloon into the PFO and providing energy to the PFO. Stambaugh et al does not disclose providing energy "only from the right side of the heart". Auth et

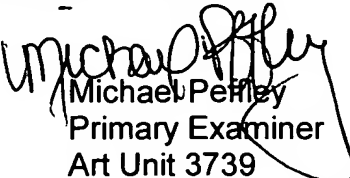
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al (2004/0243122) discloses an apparatus and method for treating the PFO with energy, and applies energy from a right side of the heart, but is not prior art in view of applicant's priority claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Michael Peffley
Primary Examiner
Art Unit 3739

mp
September 15, 2006